

REMARKS/ARGUMENTS

Claims 1-11, 13, and 14 are pending in this application.

Applicant notes for the third time that the Examiner has again failed to list U.S. Patent No. 5,259,498 (Weisburn et al.) and U.S. Patent No. 6,438,638 (Jones et al.), which have been used in previous prior art rejections of the claims of the present application, on any Notice of References Cited (PTO-892). Accordingly, as in the Amendments filed on December 1, 2005 and May 12, 2006, Applicant respectfully requests that the Examiner provide a Notice of References Cited (PTO-892) which lists these two references, so as to ensure that these references are listed on the front of any patent which eventually issues from the present application.

Claims 1, 5, 7-10 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Francis et al. (U.S. 5,011,010) in view of Farag et al. (U.S. 6,844,872). Claims 2-4, 6, 11, and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Francis et al. in view of Farag et al., and further in view of Nakayama (U.S. 6,413,630). Applicant respectfully traverses the rejections of Claims 1-11, 13, and 14.

Claim 1 recites:

A card-like computer peripheral device, comprising:
a sheet member including a draw-processed sheet member treated with coloring or marking; and
a transparent or translucent cover case; wherein
the sheet member includes an upper portion and three side portions;
each of the upper portion and the three side portions of the sheet member is connected to one another by rounded joint portions;
the sheet member is fitted into the cover case such that the sheet member extends in close contact with an inner surface of the cover case;
the sheet member is a three-dimensional member;
each of the three side portions extends substantially perpendicularly downward from the upper portion; and
the rounded joint portions connect the three side portions to the upper portion. (emphasis added)

Applicant's Claim 8 recites features that are similar to the features recited in Applicant's Claim 1, including the above-emphasized features.

The Examiner alleged that Francis et al. teaches all of the features recited in Applicant's Claims 1 and 8, except for the features of "the sheet member is a three-dimensional member; each of the three side portions extends substantially perpendicularly downward from the upper portion; and the rounded joint portions connect the three side portions to the upper portion." The Examiner further alleged, "Farak et al. discloses the sheet member (element 90 in figure 4) is a three-dimensional member; each of the three side portions (left or right portions and both sides of 90 in figure 4) extends substantially perpendicularly downward from the upper portion; and the rounded joint portions connect the three side portions to the upper portion (the rounded joint appears to connect the three sides to upper portion, see figure 4)."

Thus, the Examiner concluded, "it would have been obvious for one [of] ordinary skill in the art at the time of the invention to have provided the three dimensional member as taught by Farak et al. in the devices of Francis et al. for the benefit of keeping the member in place." Applicant respectfully disagrees.

First, as argued in the Amendment filed on May 12, 2006, Francis et al. is directed to a compact disc container. Francis et al. fails to teach or suggest any card-like computer peripheral device, or that the container of Francis et al. could or should be used as a component of a card-like computer peripheral device. In fact, the compact disc container of Francis et al. is completely unsuitable for use as a component of a card-like computer peripheral device. Thus, Francis et al. clearly fails to teach or suggest the feature of "[a] card-like computer peripheral device" as recited in Applicants' Claim 1, and similarly in Applicants' Claim 8.

Second, Farak et al. is directed to a computer mouse, whereas Francis et al. is directed to a compact disc container. In other words, Farak et al. is clearly non-analogous art to Francis et al. Thus, one of ordinary skill in the art would not have looked to Farak et al. to cure the deficiencies of Francis et al.

Third, there would have been absolutely no motivation or reason to combine the teachings of Farag et al. with Francis et al. The Examiner alleged that the motivation to combine the alleged teachings of Farag et al. with Francis et al. would have been "for the benefit of keeping the member in place." This is clearly incorrect.

The printed insert of Francis et al., which the Examiner alleged corresponds to the sheet member recited in Applicant's Claims 1 and 8, is a **two-dimensional, flat sheet** that is inserted into the slot 50. Since the flat sheet of Francis et al. is completely enclosed within the slot 50 and the associated side walls thereof, there would have been no problem with keeping the member in place.

In addition, as seen in Fig. 4 of Farag et al., element 90 of Farag et al., which the Examiner alleged corresponds to the sheet member recited in Applicant's Claims 1 and 8, has a curved, bulbous shape that could not possibly fit into the slot 50 of Francis et al. In fact, the entire structure of the compact disc container of Francis et al. would have had to be completely reconfigured to accommodate the element 90 of Farag et al.

Furthermore, rather than being motivated to combine the teachings of Farag et al. with Francis et al, one of ordinary skill in the art would have been motivated not to combine teachings of Farag et al. with Francis et al. because, as is readily well-known in the art, it is desirable to reduced the thickness of compact disc containers so as to enable a greater number of compact disc containers to be stacked in a smaller space. If the compact disc container of Francis et al. were completely reconfigured so as to accommodate the element 90 of Farag et al., the thickness of the compact disc container of Francis et al. would disadvantageously be substantially increased.

Thus, contrary to the Examiner's allegations one of ordinary skill in the art would not have been motivated to combine the alleged teachings of Farag et al. with Francis et al.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Francis et al. in view of Farag et al.

The Examiner relied upon Nakayama to allegedly cure deficiencies of Francis et al. and Farag et al. However, Nakayama clearly fails to teach or suggest the features of "[a] card-like computer peripheral device," "the sheet member is a three-dimensional member," "each of the three side portions extends substantially perpendicularly downward from the upper portion," and "the rounded joint portions connect the three side portions to the upper portion" as recited in Applicant's Claims 1 and 8. Thus, Applicants respectfully submit that Nakayama fails to cure the deficiencies of Francis et al. and Farag et al. described above.

Accordingly, Applicants respectfully submit that Francis et al., Farag et al., and Nakayama, applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in Applicant's Claims 1 and 8.

In view of the foregoing remarks, Applicant respectfully submits that Claims 1 and 8 are allowable. Claims 2-7 and 9-11, 13, and 14 depend upon Claims 1 and 8, and are therefore allowable for at least the reasons that Claims 1 and 8 are allowable.

In view of the foregoing remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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/Christopher A. Bennett #46,710/
Attorneys for Applicant(s)

KEATING & BENNETT, LLP
8180 Greensboro Drive, Suite 850
Tyson's Corner, VA 22102
Telephone: (703) 637-1480
Facsimile: (703) 637-1499

Joseph R. Keating
Registration No. 37,368

Christopher A. Bennett
Registration No. 46,710